

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LON T. SPADA and PAUL T. BUTORAC

Appeal 2007-1856
Application 10/808,652
Technology Center 3700

Decided: October 24, 2007

Before JENNIFER D. BAHR, LINDA E. HORNER, and JOSEPH A. FISCHETTI,
Administrative Patent Judges.

FISCHETTI, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claim 1. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a closure device for a dropper bottle which is said to provide for simultaneous sealing of a nozzle outlet and protection of internal formations for enabling engagement and disengagement of the closure with a bottle (Specification 1:3-8).

Claim 1, reproduced below, is the only claim on appeal.

1. A closure for a dropper bottle, said closure comprising:
a nozzle disposed on the bottle and having a neck and a shoulder, said neck having an aperture at an end thereof for dropwise dispensing of a liquid, said shoulder having an outstanding circumferential ring and threads disposed between the ring and said neck;
a concave surface subtending said aperture; and
a cap having a top and an axially downwardly extending skirt, said top having a seat, including a convex surface, for sealably engaging said aperture, said skirt having internal grooves for engaging the shoulder threads and an internal circumferential lip for sealably engaging the ring, the lip being spaced apart from said aperture for enabling simultaneous sealing of said aperture and the ring upon rotation of said cap onto said nozzle, the concave and convex surfaces having equal radii for enabling a sealed rotational engagement with one another without entry into said aperture.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Baudin	US 6,152,324	Nov. 28, 2000
Gerondale	US 2004/0140319 A1	Jul. 22, 2004

The following rejections are before us for review.

1. Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

2. Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerondale in view of Baudin.

ISSUES

The first issue before us is whether the Specification, as originally filed, conveys with reasonable clarity to those skilled in the art that the aperture 38 in the neck 18 of the nozzle 12 has a concave surface subtending it, and that the radius of this concave surface is equal to that of the convex surface on the seat of the cap 30.

The second issue is whether Appellants have sustained their burden of showing that the Examiner erred in rejecting claim 1 as being unpatentable under 35 U.S.C. § 103(a) over Gerondale in view of Baudin. In particular, Appellants argue that the proposed combination would not result in an operable device (Appeal Br. 5).

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Specification as originally filed on March 24, 2004 fails to describe that: (1) the aperture 38 in the neck 18 has a subtending concave surface, and (2) the radius of this concave surface is equal to the radius of the convex surface on the seat of the cap.

2. Appellants amended claim 1 on July 25, 2005 to include additional limitations (as underlined): (1) a concave surface subtending said aperture; (2) said top having a seat, including a convex surface, and (3) the concave and concave surfaces having equal radii for enabling a sealed engagement with one another

without entry into said aperture.

3. By an Amendment¹ dated October 17, 2005, Appellants attempted to provide support to the Specification for the claim language added in the July 25, 2005 Amendment (FF 2) by amending the Specification to recite:

As shown in Figure 3, the seat 36 includes a convex surface 36a and a concave surface 38a subtends the aperture 38. As illustrated, the convex surface 36a and concave surface 38a have equal radii for enabling a sealed engagement with one another.

4. In reply to the October 17, 2005 Amendment (FF 3), the non-final Office Action dated December 6, 2005 states that “the changes to the paragraph on page 5 are all new matter except for the seat having the convex surface. The drawings and the rest of the original disclosure do not support the concave surface and the equal radii” (Non-Final Office Action 2).

5. Since the Office Action dated December 6, 2005 does not explicitly refuse entry of the Amendment to the Specification dated October 17, 2005, it is unclear from the record whether the Amendment was entered or not.

6. The drawings, as originally filed, show the aperture 38 in Figures 1 and 3 defined by a surface, but the shape of that surface cannot be ascertained.

7. The Examiner found that: (1) Gerondale discloses all the features of claim 1 except for concave and convex surfaces respectively associated with the aperture and the seat, and each such surface having equal radii, and (2) it would have been obvious to one of ordinary skill in the art “to provide the matching

¹ Also submitted with the Amendment dated October 17, 2005 was a replacement sheet of drawings in which lead lines 36a and 38a were added.

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concave and convex structures as taught by Baudin on the device of Gerondale in order to provide a more complete seal and thus help prevent drying of the product around the aperture.” (Final Office Action 3.)

8. Baudin discloses a cap 8 having: (1) a seat 14 surrounding a convex surface 40 and (2) a concave surface defined by member 21 on the neck 6 (Baudin, Figure 3). The convex surface 40 and the concave surface 21 are disclosed as having matching shapes (Baudin, col. 5, ll. 14-15) which is otherwise interpreted as having equal radii.

PRINCIPLES OF LAW

The factual inquiry for determining whether a specification provides sufficient written description for the claimed invention is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

Under 35 U.S.C. § 103, a claimed invention is unpatentable if the differences between the subject matter sought to be patented and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” *KSR Int’l v.*

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Teleflex Inc., 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14, 148 USPQ 459, 465-66 (1966).

ANALYSIS

We affirm the rejection of claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. We also affirm the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Gerondale in view of Baudin.

The 35 U.S.C. § 112, First Paragraph, Rejection

We determine whether the Examiner's rejection of claim 1 under 35 U.S.C. § 112, first paragraph was proper by reviewing the Specification as originally filed.

Appellants argue that the claimed subject matter "directed to concave and convex surfaces [are] ...clearly set forth in the drawings which also show that the surfaces have equal radii" (Appeal Br. 4-5). We disagree.

The original drawings do not display with reasonable clarity: (1) a concave surface which subtends the aperture 38, or (2) that concave and convex surfaces on the tip and the cap have equal radii (FF 4, 6). Further, the drawings as originally filed show in Figures 1 and 3 that the aperture 38 in the neck 18 is defined by a surface, but the shape of that surface cannot be ascertained (FF 6).

Second, even if it could be gleaned from the drawings that the surface subtending the aperture 38 is concave, there is nothing in the Specification as originally filed describing that the concave and convex surfaces of the aperture and

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the top, respectively, have equal radii (FF 1, 4). The drawings also do not provide support for two surfaces having equal radii (FF 4, 6).

We therefore conclude that the Specification as originally filed does not provide written description support for the claim language added by the Amendment dated July 25, 2005 (FF 2). We therefore sustain the rejection of claim 1 under 35 U.S.C. § 112, first paragraph.

The 35 U.S.C. § 103(a) Rejection

We sustain the 35 U.S.C. § 103(a) rejection based on Gerondale in view of Baudin.

Appellants argue:

Baudin discloses a snap cap 8 which includes a smooth bulge 40 shaped to match the concave side of the membrane 21. Clearly, because of the hinge nature of the cap, rotational sealed engagement is not possible, nor taught.

In addition, the combination of Gerondale and Baudin would not result in an operable device. Accordingly, under these circumstances, a combination of the references is improper [Appeal Br. 5-6].

We are not persuaded by the argument that the combination of Gerondale and Baudin is inoperable because in the proposed combination, the cap 8 in Baudin would be rotatably and not hingedly connected to the dispenser. Nowhere is it proposed to modify Baudin to replace its hinge 9 with a screw threaded connection as Appellants allege. Rather, what the Examiner proposed was to modify

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Gerondale to include Baudin's concave and convex mating surfaces between the tip 7 and the cap 4 of Gerondale (FF 7). If Gerondale described all the limitations, then the Examiner would have made an anticipation rejection. What Appellants' argument amounts to is a "divide and conquer" approach—since Gerondale does not show it all, then the combination of Gerondale and Baudin is "no good." Sometime ago, however, binding precedent made clear that an obviousness rejection cannot be overcome by attacking references individually—which is precisely what appellants are doing. *In re Young*, 403 F.2d 754, 757, 159 USPQ 725, 728 (CCPA 1968).

CONCLUSIONS OF LAW

We affirm the rejection of claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

We affirm the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Gerondale in view of Baudin.

DECISION

The decision of the Examiner to reject claim 1 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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WALTER A. HACKLER, Ph.D.
PATENT LAW OFFICE
SUITE B
2372 S.E. BRISTOL STREET
NEWPORT BEACH, CA 92660-0755